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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/665,694	09/20/2000	Takuya Matsumoto	500.39093X00	5603
20457	7590	10/06/2003	EXAMINER	
ANTONELLI, TERRY, STOUT & KRAUS, LLP 1300 NORTH SEVENTEENTH STREET SUITE 1800 ARLINGTON, VA 22209-9889			PUNNOOSE, ROY M	
		ART UNIT	PAPER NUMBER	
		2877		

DATE MAILED: 10/06/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

A/R

Office Action Summary	Application No.	Applicant(s)
	09/665,694	MATSUMOTO ET AL.
	Examiner	Art Unit
	Roy M. Punnoose	2877

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on ____.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-20 is/are pending in the application.
 - 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) Claim(s) 2-7, 17 and 18 is/are allowed.
- 6) Claim(s) 1,10 and 13 is/are rejected.
- 7) Claim(s) 8,9,11,12 and 14-16 is/are objected to.
- 8) Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on ____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on ____ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. ____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
 - a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____ . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>3,4,6</u> . | 6) <input type="checkbox"/> Other: ____ . |

DETAILED ACTION

Election/Restrictions

1. Applicants' election to the restriction requirement of the previous office action is acknowledged. However, upon review of the applicants' response, the Examiner has realized that the species type restriction applied to the claims is incorrect. The Examiner therefore has withdrawn the restriction requirement of the previous office action. The Examiner sincerely regrets the error and apologizes for any inconvenience this may have caused. The new restriction requirement is detailed below.

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-20, drawn to a near-field optical probe, classified in class 356, subclass 601.
 - II. Claims 21-23, drawn to near-field optical microscope and an optical recording reading device employing an automatic adjusting method, classified in class 359, subclass 368.
 - III. Claims 24-27, drawn to an optical recording/reading device using a recording disk including a near-field optical probe in a cartridge, classified in class 369, subclass 47.1.

 - IV. Claims 28, drawn to an optical recording/reading device using a recording disk, including a metallic layer below a recording layer, classified in class 369, subclass 13.01.

3. Inventions II and I are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case, invention I pertains to a near-field optical probe while invention II discloses an automatic adjusting method.

4. Inventions III and II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case, invention II pertains to an automatic adjusting method while invention III discloses an optical recording/reading device using a recording disk including a near-field optical probe in a cartridge.

5. Inventions IV and III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case, invention III is directed to an optical recording/reading device using a recording disk including a near-field optical probe in a cartridge, whereas invention IV discloses an optical recording/reading device using a recording disk, including a metallic layer below a recording layer.

6. Inventions IV and I are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case, invention I

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pertains to a near-field optical probe while invention IV an optical recording/reading device using a recording disk, including a metallic layer below a recording layer.

7. Inventions III and I are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case, invention I pertains to a near-field optical probe whereas invention III is directed to an optical recording/reading device using a recording disk including a near-field optical probe in a cartridge.

8. Inventions IV and II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case, invention II is directed to an automatic adjusting method, whereas invention IV discloses an optical recording/reading device using a recording disk, including a metallic layer below a recording layer.

9. Because these inventions are distinct for the reasons given above and the search required for

- a. Group II is not required for Group I,
- b. Group III is not required for Group II,
- c. Group IV is not required for Group III,

- d. Group I is not required for Group IV,
- e. Group I is not required for Group III, and,
- f. Group II is not required for Group IV,

restriction for examination purposes as indicated is proper.

10. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

11. During a telephone conversation with Attorney Melvin Kraus (Registration No. 22,466) on September 16, 2003 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-20. Applicant in replying to this Office action must make affirmation of this election. Claims 21-28 have withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention. Accordingly, the applicant is requested to cancel all non-elected claims in response to this office action.

Claim Rejections - 35 USC § 112

12. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

13. Claims 19 and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 19 is directed to a near-field optical microscope comprising a near-field optical probe. It appears that the applicant's main invention is a microscope and not the near-field probe as claimed in claim 1. Appropriate correction is required.

Similarly claim 20 is directed to an optical recording/reading device comprising a near-field optical probe. It appears that the applicant's main invention is an optical recording/reading device and not the near-field probe as claimed in claim 1. Appropriate correction is required.

Claim Rejections - 35 USC § 102

14. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

15. Claims 1, 10 and 13 are rejected under 35 U.S.C. 102(a) as being anticipated by Hirokane et al (US 5,982,409).

With regard to claims 1, 10 and 13, Hirokane et al (Hirokane hereinafter) discloses a near-field optical probe comprising a substrate 1 and a metallic scatterer 3 fabricated on said substrate 1 in a contour of a circular cone having an axis vertical to the surface of the substrate 1, (see col.4, lines 45+; Figures 2 and 14), including a dip 1a in the substrate 1 with depth substantially equal to height of said scatterer 3, wherein said scatterer is formed in said dip 1a, and, said near-field optical probe further comprising a condensing element 110 on said substrate 1 (see Figures 25 and 26).

Allowable Claims

16. Claims 2-7 and 17-18 are allowable over prior art.

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17. Claims 8-9, 11-12 and 14-16 are objected to as being dependent on a rejected base claim.

Conclusion

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Examiner Roy M. Punnoose** whose telephone number is **703-306-9145**. The examiner can normally be reached on 9:00 AM - 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the applicant can reach his **Supervisory Patent Examiner, Frank G. Font**, at (703) 308-4881.

The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and 703-872-9306 for After Final communications.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-0530.

Roy M. Punnoose
Patent Examiner
Art Unit 2877
September 21, 2003



Mr. Frank G. Font
Supervisory Patent Examiner